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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
07/580,246	09/10/1990	DONALD R. HUFFMAN	7913Z	5441

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SCULLY, SCOTT, MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580246

Applicant(s)

Huffman

Examiner

Nedrickson

Group Art Unit

1759

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 7/11/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1-1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 45-51, 53-1511, 8081, 8386, 86-90, 92-107, 109-180 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 85, 90, 94, 95 is/are allowed.
- ☒ Claim(s) 45-51, 53-1511, 8081, 8386, 8889, 92-107, 109-180 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received

In this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejections, comments and arguments made in the withdrawn rejection of 11/30/93 are hereby repeated, and they are incorporated herein by reference. To summarize, the rejections are:

- objection to specification for 'macroscopic quantities/amount'.
- '112 first paragraph for 'macroscopic quantities/amount', applied to claims 53-72, 86, 96-107, 111-152, 154-180.
- '112 second paragraph for 2 cases of indefinite language, applied to claims 97-101, 109, 110, 115-118, 120, 121, 133-140, 156, 158-161, 171-180.
- '112 fourth paragraph, applied to claims 133, 134, 138, 161.
- '101 as being naturally occurring, applied to claims 45-51, 53-75, 77, 80, 81, 83, 86, 88, 92, 93, 96-107, 109-180.
- '102/103 in view of Kroto/Curl, applied to claims 45-51, 53-75, 77, 80, 81, 83, 84, 86, 88, 89, 92, 93, 96-107, 109-180.

The rejection over Kratschmer is withdrawn.

Applicant's arguments filed 7/17/02 have been fully considered but they are not persuasive.

Concerning the term 'macroscopic' this issue has been decided in other proceedings. As no new matter in the specification has been added by this amendment, the determination of what is present therein remains the same as before. The arguments appear to be repeats of those made earlier; that a solution is colored does not imply that a macroscopic solid is present. The argument on pg. 16 is conclusionary, as it presupposes that macroscopic amounts of solid were deemed to have been prepared previously with different sizes of graphite, but this has not been accepted.

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Concerning the recognition by others that macroscopic amounts were made, it is true that this term has long been applied to the original process. See

Seshadri et al. Tetrahedron Letters vol. 33 (no. Unknown) pg. 2069 1992.

Bethune et al. Chem. Phys. Lett. Vol. 179 no. 1,2 pg. 181 12 April 1992.

Saito et al. Chem. Phys. Lett. Vol. 204 no. 3,4 pg. 277 19 March 1993.

It is not known what their criteria were.

The 4th paragraph rejection is maintained, as it is not agreed that a minute amount of a colored solution represents a macroscopic amount, even though the rejected claims recite a larger amount than this. Concerning Kroto/Curl, there is insufficient data to determine how much C60 is needed to be a 'solid' or a 'crystal'; the implication that this is an amount which is greater than what was just argued as constituting a 'macroscopic amount' is not accepted as it is not logical.

The Declarations are noted. The Declaration of Loutfy concerning the experiments is speculative. Concerning macroscopic, it repeats earlier arguments. The Declaration of Moravsky was sufficient to overcome the Kratschmer rejection. The other Declarations recited are taken to be references to old Declarations, no other new Declarations were found. It is not necessary to resubmit Declaration which repeat statements made in earlier Declarations, and given the amount of time since the original filing, only experiment Declarations should be filed, as conversations and observations made in 1990 may be misremembered or incomplete.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

A handwritten signature in black ink, appearing to read 'Stuart Hendrickson', is positioned above the printed name.

Stuart Hendrickson
Primary examiner Art Unit 1754